UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,340	04/12/2001	Rabindranath Dutta	AUS920010213US1	3781

35525 7590 11/22/2005

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380

EXAMINER	
MILEF, ELDA G	
ART UNIT	**PAPER NUMBER**
3628	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/833,340	DUTTA ET AL.	
	Examiner	Art Unit	
	Elda Milef	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 8/04/2005
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1,4-6,8,9,12-14,16,17,20-22,24 are rejected under 35 U.S.C. 102(e) as being anticipated by Jones (PG. Pub. US 2002/0145035).

Re claim 1: Jones discloses:

receiving a check image of the check from an automatic teller machine, wherein the check image is generated by a scanner in the automatic teller machine ("The documents could be received at a full image scanner located at a teller line, a drive-up window, an ATM…")-see para. 56;

performing optical character recognition on the check image to generate data ("For example, when processing checks, the scanhead may be directed by the OCR software to search for the

'$' symbol…Then based on the outcome of the previous step, certain fields of interest are located and the information is stored for use by the system…")-see para. 51.

performing check clearing processes using the check image and the data ("A further object of some embodiments of the present invention is to provide a document processing system which obtains approval for payment of documents, such as checks, through the ACH system.")-see para. 3 and ("At this point, the check images may be communicated via a communication link to a central clearinghouse (or central computer 18 as shown in FIG.1…")-see para. 37 , ("image data")-para. 51, Abstract, pars. 3, 56, 66, 81.

Adding check clearing information to the check image ("The image processor may add items to the image.")-see para. 51 and("The scanning system would add to the image any other fields which were desired i.e. payee name and amount.")see para.36, and pars. 55,62,77, and Fig.7.

Re claim 4: Jones discloses:

Wherein the check image includes a front side and a back side of the check. ("When the document moves into a position 76b, the image of one of the first or second sides of the document travels along a first path 72 to a mirror 70…Thus one side of the document is imaged using reflection techniques.

The document 61 then moves into position 76c where the image of the other of the first and second sides of the document is scanned by the scanhead 80.")-see pars. 46, 47,48.

Re claim 5: Jones discloses:

Wherein the step of adding check clearing information to the check image comprises adding overlay prints providing check clearing information, wherein check clearing information includes an identification of a financial institution clearing the check; a name of a financial institution clearing the check; a transaction number, a type of transaction and a date of transaction.

(" if the item scanned is a check, an endorsement stamp may be added to the image which includes the bank and account number which is to be credited. Alternatively, the bank information could be added to the file as a separated line item.")-see para. 35, also, see pars. 36, 37, 40, 41, 55, 61,62,77, Fig.7.

Re claim 6: Jones discloses:

the check image received from an automatic teller machine through a communications link. ("At this point, the check images may be communicated via a communication link to a central clearinghouse…")-see para. 37.

Re claim 8: Jones discloses wherein the step of performing check clearing processes occurs at a clearinghouse, and wherein

the clearinghouse performs check settlement. ("At this point, the check images may be communicated via a communication link to a central clearinghouse…")-see para. 37 and("communicating information represented by the image of the document to a central clearinghouse for processing of the document.")-see p.9, Claim 32, and para. 10.

Re claims 9,12-14,16: Further a data processing system for processing a check would have been necessary to perform previously rejected claims 1,4-6,8 and are therefore rejected using the same art and rationale.

Re claims 17,20-22,24: Further a computer program product would have been necessary to perform previously rejected claims 1, 4-6, 8 and are therefore rejected using the same art and rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1, 9,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramster (Ramster, Claire. *End of the Paper Chase. Banking Technology*, v14, n6, p32-36, Jul/Aug 1997.) in view of AT&T (*AT&T Global's Check Image Feature Expected to Boost Deposits at ATMs. American Banker.* Vol. CLIX, n 236, p17 December 09,1994 in further view of Jones.

Re claim 1: Ramster discloses:

receiving a check image of the check from an automatic teller machine, wherein the check image is generated by a scanner in the automatic teller machine; and performing check clearing processes using the check image and the data. ("Some scanners are located at the point where documents are accepted.

For example, scanners are found next to bank tellers and in ATMs to capture images of cheques as they are deposited. Scanners can also have built-in software which automatically processes, recognises [sic] and enters information (such as amounts and account numbers) as the image is scanned.")—see p.2, para. 2,3, and ("POD aims to speed up processing of unencoded deposits using imaging and amount recognition and transaction balancing technologies that automate data entry. Deposits can be processed at speeds of 500 documents per minute")-see p. 2, pars. 7-9.

Ramster does not disclose performing optical character recognition on the check image to generate data. AT&T however, discloses ("AT&T Global Information Solutions (Dayton, OH) has released a new automated teller machine (ATM) that displays an image of a check deposited for the customer to see and electronically scans for signatures and amounts for accuracy and completion. The machine, called a DP-ATM, can also be designed to handle magnetic ink character recognition and optical character recognition…")-see lines 1-6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ramster by incorporating scanning the check image using optical character recognition to generate data, as was done by AT&T, in order to

use the data in processing the check, provide information to customers, and increase the speed of processing the check information.

Although Ramster discloses adding proof of deposit information to the check image ("The scalability and flexibility of the ImageMark approach allowed us to start with image statements, add POD (proof of deposit) imaging…"), Ramster and AT&T do not specifically disclose adding check clearing information to the check image. Jones however, shows ("The image processor may add items to the image.")-see para. 51 and("The scanning system would add to the image any other fields which were desired i.e. payee name and amount.")see para.36, and pars. 55,62,77, and Fig.7. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ramster and AT&T to include adding items to the check image as was done by Jones in order to aid in the processing of the data captured from the check.

Re claim 9: Further a data processing system for processing a check would have been necessary to perform previously rejected claim 1 and is therefore rejected using the same art and rationale.

Re claim 17: Further a computer program product would have been necessary to perform previously rejected claim 1 and is therefore rejected using the same art and rationale.

3. Claims 2, 3, 10, 11, 18, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Ramster (Ramster, Claire. *End of the Paper Chase. Banking Technology*, v14, n6, p32-36, Jul/Aug 1997.)

Re claim 2: Although Jones discloses returning the checks to customers -see pars. 37 and 38, Jones does not specifically disclose sending the check image to an issuer of the check.

Ramster discloses: ("Rather than providing the information in mountains of unwieldy paperwork, the customers receive data and images in a manageable disk format that lets them search for specific information quickly. Wachovia also provides software that enables customers to manage the images and data and even have online access to information stored in the corporation's archives. This is also beneficial to Wachovia Corp. It does not have to pay to send heaps of processed cheques to customers for their own records. and neither Wachovia nor its customers have to rehandle the same bits of paper when the cheques are sent out.")-

see p.3, para. 8,9. It would have been obvious to one having ordinary skill in to send the check image to customer in order to reduce the amount of paperwork handled by the customer and banks.

Re claim 3: Although Jones discloses returning the checks to customers -see pars. 37 and 38, Jones does not specifically disclose printing the check image on paper to form a paper copy of the check; and sending the paper copy of the check to the issuer. Ramster discloses ("When a customer pops a cheque into an ATM, an imaging system can reassure them that the cheque has been received by the system by printing a copy of the cheque on their receipt… Rather than providing the information in mountains of unwieldy paperwork, the customers receive data and images in a manageable disk format that lets them search for specific information quickly. Wachovia also provides software that enables customers to manage the images and data and even have online access to information stored in the corporation's archives.

This is also beneficial to Wachovia Corp. It does not have to pay to send heaps of processed cheques to customers for their own records. And neither Wachovia nor its customers have to rehandle the same bits of paper when the cheques are sent out…")-see pp.3 and 4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to

include the imaging system printing a copy of the check on the receipt as was shown by Ramster in order to provide a record of the transaction to the customer.

Re claims 10 and 11: Further a data processing system for processing a check would have been necessary to perform previously rejected claims 2 and 3 and are therefore rejected using the same art and rationale.

Re claims 18 and 19: Further a computer program product would have been necessary to perform previously rejected claims 2 and 3 and are therefore rejected using the same art and rationale.

4. Claims 7, 15, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Medina(Medina, Maria. *New Applications for Text Recognition.* Imaging & Document Solutions. San Francisco: Dec 2000. Vol. 9, Iss. 12; 6 pages.

Re claim 7: Jones discloses wherein data generated through optical character recognition on the check image is used to create a text document to form an electronic check ("the full image scanner 312, such as described above, scans the full image of the document, recognizes certain fields within the document,

and processes information contained within these fields in the document, such as extracting data from the images of the documents. For example, OCR software may be used to extract data which can be stored in ASCII or other text formats. The system may also be used to capture any document image for electronic document display, electronic document storage, electronic document transfer, electronic document recognition (such as denomination recognition or check amount recognition) or any other processing function that can be performed using an electronic image.")-see para. 80.

Although Jones discloses storing extracted data in a text format, Jones does not specifically disclose a markup language format. It is well known in the art, as evidenced by Medina, that it is common for text recognition applications to be converted to markup language files such as HTML (Hypertext Markup Language). -see p. 1, para. 3 (full text)-("By applying recognition, you can make images searchable and retrievable , and you can convert them into Web-ready HTML or searchable PDF files.") Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include that the data obtained from the OCR of the image be converted to HTML format as was shown by Medina so

as to allow the information to be viewed as a Web page over the Internet.

Re claim 15: Further a data processing system for processing a check would have been necessary to perform previously rejected claim 7 and is therefore rejected using the same art and rationale.

Re claim 23: Further a computer program product would have been necessary to perform previously rejected claim 7 and is therefore rejected using the same art and rationale.

Response to Arguments

5. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600